

Appln. No. 09/751,801  
Amendment dated September 30, 2005  
Reply to Office Action mailed December 27, 2005

### REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1 through 5, 7 through 22, and 24 through 49 remain in this application. Claims 6 and 23 have been cancelled. No claims have been withdrawn or added.

### Paragraphs 2 and 3 of the Office Action

Claims 1 through 5, 7 through 22, 24 through 43, and 45 through 49 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dowling et al (U.S. 6,522,875) in view of Marwell (US 6,404,884).

Claim 44 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Dowling et al (U.S. 6,522,875) and Marwell (US 6,404,884), further in view of McAuliffe et al (U.S. 5,838,790).

Claim 1, as amended, requires "modifying the acceptance data by integrating at least one entry from a personal information manager" and "wherein the step of modifying the acceptance data includes converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product". Claim 14 requires "creating preferences for selecting advertisements" and "wherein the step of creating the preferences for selecting advertisements includes converting at least one entry from a personal information manager into at least one product that corresponds to the at least one entry, and modifying the preferences to select advertisements for the at least one product from the one or more broadcast

Appln. No. 09/751,801

Amendment dated September 30, 2005

Reply to Office Action mailed December 27, 2005

advertisements received by the communication device". Claims 19 and 28 require (similarly, but not identically) "logic for modifying the acceptance data by integrating at least one entry from a personal information manager, wherein the logic for modifying the acceptance data includes logic for converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and logic for adding the at least one product to the acceptance data to accept broadcast advertisements for the at least one product". Claim 33 requires "a mobile communication device capable of storing acceptance data thereon, the mobile communication device being capable of modifying the acceptance data by integrating at least one entry from a personal information manager, the mobile communication device being capable of converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product".

With respect to the requirements of claim 1 of "converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product", it is conceded in the rejection of the Office Action that (emphasis in original):

Dowling fails to teach that said input-output module is *a personal information manager*.

It is then asserted that:

However, Marwell teaches in column 1, lines 20-35 that "Society's demand for virtually instantaneous access to information, and the need to quickly contact others is constantly increasing. To meet this demand, personal information manager (PIM) software for various types of computers, personal digital assistants (PDA) and global communication networks, such as the Internet, have been developed which facilitate access to data. For example, a person may have contact and telephone numbers stored in their PDA or electronic

Appln. No. 09/751,801

Amendment dated September 30, 2005

Reply to Office Action mailed December 27, 2005

organizer, such that they can quickly determine the phone number of the person they wish to reach. Similarly, they may have a PIM database on their laptop which contains the same information, such that the PIM and PDA databases are harmonized, i.e., synchronized. Recently developed Internet software allows a user to harmonize a PIM contact information database with an Internet web site". Dowling teaches in column 17, lines 60-67 that "In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer".

However, it is noted that while the quoted portion of the Marwell patent discusses synchronization of the PIM information between a PDA and a laptop, there is no mention of any "converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product", as required by claim 1. The quoted portion of Marwell *does not* disclose any transfer of PIM information to other programs or applications (other than another PIM program on a different computer), and is submitted to be more likely to suggest to one of ordinary skill in the art the sharing of information between similar PIM programs, and *not* any exporting PIM information to other types of programs. The discussion of "harmonization" and "synchronization" In this portion of Marwell does not lead one of ordinary skill in the art to understand that any entry in a PIM should be used to modify acceptance data, particularly by adding a product to acceptance data to permit acceptance of advertisements relating to the product.

Further, with respect to the portion of the Dowling patent referenced in the Office Action, it is noted that the Dowling patent states at col. 17, line 60 through col. 18, line 6, that (emphasis added):

In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer. A user carrying the palm-pilot version of the mobile unit 105 enters a shopping mall and is looking for a silver plated picture frame under fifty dollars.  
Information to this effect is entered by the user as discussed above and

Appln. No. 09/751,801

Amendment dated September 30, 2005

Reply to Office Action mailed December 27, 2005

a user-interest packet is transmitted according to the first step 515. The local broadcast domain entity 150 is preferably controlled by the shopping mall authorities or a contracted advertising company. The steps 520 and 525 then are performed to determine which stores carry the item of interest. If any of the stores within the shopping mall carry the item of interest, the decision 530 evaluates affirmatively and a packet will be transmitted back to the mobile unit 150 as discussed below.

While this portion of the Dowling disclosure does discuss the use of the system on a PDA, there is no teaching or suggestion of any transfer of information from another program, particularly a PIM, to the Dowling system. The possibility of implementing the Dowling system on a PDA does not clearly or necessarily lead one of ordinary skill in the art to any exchange of information between a PIM and the Dowling system. In fact, the description here in Dowling clearly indicates that the product identity information is entered by the user, and not transferred from any other program such as a PIM. It is therefore submitted that the Dowling patent would not lead one of ordinary skill in the art to "converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product", as required by claim 1.

It is further asserted in the rejection of the Office Action that:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dowling's PDA mobile device would have a PIM software installed in said device, as taught by Marwell, which would allow users to input preference or acceptance data in said PDA. Dowling would have been motivated to include a PIM software in a PDA device in view of society's demand for virtually instantaneous access to information and to make it easier to access and input data into said PDA.

The discussion in the Office Action appears to concentrate on whether one of ordinary skill in the art would have found it obvious to employ the Dowling system on a PDA, and whether one of ordinary skill in the art

Appln. No. 09/751,801  
Amendment dated September 30, 2005  
Reply to Office Action mailed December 27, 2005

would have found it obvious to employ a PIM on a PDA, so that both programs might be on the same PDA at the same time. However, whether or not a personal information manager is incorporated into the PDA as allegedly suggested by Marwell, and whether the Dowling system may also be employed on a PDA, the rejection of the Office Action does not appear to address the substance of the requirement that is addressed in this portion of the rejection, namely that of "*converting* the at least one entry from the personal information manager *into* at least one product that corresponds to the at least one entry, and *adding* the at least one product to the acceptance data *to accept advertisements for the at least one product*". Merely because the Dowling system may be present on a PDA, does not necessarily establish that information, and particular an entry, from a PIM would be transferred to the Dowling system. The cited portion of Dowling seems to lead one of ordinary skill in the art away from such a link up, as the discussion in Dowling clearly discusses the user entering such information. It is submitted that the discussion of the rejection with regard to this clause of the claim completely disregards the substance of this clause, and appears to assume that, if the PIM program and the Dowling system are resident in the PDA, then the steps of "converting" and "adding" outlined in this clause are necessarily present in the resulting device. However, it is submitted that one of ordinary skill in the art would not recognize that the transfer of any PIM information from the PIM program to the Dowling system are necessarily a result of the allegedly obvious combination of a PIM program and the Dowling system on a PDA.

Claim 1 further requires "modifying the acceptance data by integrating at least one entry from a personal information manager". Inexplicably, the quotation of this clause of claim 1 in the text of the rejection of the Office Action has been changed from the text set forth above to "modifying the acceptance data by integrating at least one entry *from a input-output module*". This is not the language of the claim 1, and it is submitted to be a

Appln. No. 09/751,801  
Amendment dated September 30, 2005  
Reply to Office Action mailed December 27, 2005

significantly different requirement than that actually set forth in claim 1. There is no reason provided in the rejection for this alteration of the apparent interpretation of the scope of claim 1. It is contended in the Office Action that the Dowling patent discloses this (altered) requirement of claim 1 at col. 9, lines 40-65, and in figure 2, item 210, 225). However, it is noted that in the Office Action mailed January 11, 2005 for the present patent application, the rejection of claim 6 (the requirements of which have since been incorporated into claim 1) stated that (emphasis added):

As per claim 6, Dowling teaches the method of claim 1, but falls to teach further comprising the step of modifying the acceptance data by Integrating entries from a personal Information manager.

Thus, the previous rejections of claims including this requirement have relied upon other patents, most recently the Huang patent, for the reason that the Dowling patent failed to disclose this feature of the applicant's claims. Contrary to the position taken earlier in the prosecution, it is now asserted in the rejection of the Office Action by the U.S.P.T.O. that the Dowling patent *does* disclose this feature of the claimed invention. The rejection specifically identifies the portion of Dowling at col. 9, lines 40 through 65, where it is stated that:

The broadcast-data packet is next routed from the broadcast reception module 220 into the input of the packet filter 225. The packet filter 225 is operative to selectively pass the broadcast-data packet if it meets a criterion encoded into one or more packet-filter parameters. The packet-filter parameters may be derived from information supplied from either the network interface module 205 and/or the user input-output module 210. The packet filter parameter typically includes one or more packet-header bit masks. If the header of the broadcast-data packet matches the bit mask, the packet is passed through the packet filter. If the header of the broadcast-data packet does not match the bit mask of the packet-filter parameter, the packet is rejected and no output packet is produced at the packet filter output. In this way, the packet filter selectively passes the broadcast packet, passing it if it matches the mask and rejecting it otherwise. The set of information deemed to be of interest to the user that will pass through the packet filter is called an "information class." Alternatively, the broadcast-data packet may contain keywords. The keywords are compared to a list of keywords provided from either the network

Appln. No. 09/751,801  
Amendment dated September 30, 2005  
Reply to Office Action mailed December 27, 2005

interface module 205 and/or the user input-output device 210. If the keyword in the keyword list of the broadcast-data packet matches a keyword list, the packet is passed through the packet filter. If no match is found, the packet is rejected.

However, it is submitted that nothing in this portion of Dowling discusses anything having to do with "modifying the acceptance data *by integrating at least one entry from a personal information manager*", as there is absolutely nothing in this portion of Dowling that mentions a personal information manager or any entries from a personal information manager. Even if one assumes for the purpose of argument that the referenced portion of Dowling does disclose "modifying the acceptance data by integrating at least one entry *from a input-output module*" as set forth in the Office Action, again, this is not the language of claim 1.

It is therefore submitted that the cited references, and especially the allegedly obvious combination of Dowling et al and Marwell set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by the claims, and it therefore submitted that the claims are in condition for allowance.

Withdrawal of the §102(b) and §103(a) rejection of claims 1 through 5, 7 through 22, and 24 through 49 is therefore respectfully requested.

Appln. No. 09/751,801  
Amendment dated September 30, 2005  
Reply to Office Action mailed December 27, 2005

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Date: DEC. 27, 2005

Jeffrey A. Proehl (Reg. No. 35,987)  
Customer No. **40,158**  
P.O. Box 5027  
Sioux Falls, SD 57117-5027  
(605)336-3890 FAX (605)339-3357